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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,495	10/14/2003	Trent J. Brundage	P0895	3545

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DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

MORAN, RANDAL D

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,495

Applicant(s)

BRUNDAGE ET AL.

Examiner

Randal D. Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 73-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Pre-appeal conference held on 3/1/2007 and the decision was made to reopen prosecution of the application.

2. Claims 7~~2~~³-106 are pending in this application.

3. Below, Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully each reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35

U.S.C. 120 as follows: the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/011129, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The parent application provides no support for the limitations of "electronic circuitry carried on or in the substrate, wherein the electronic circuitry comprises information stored therein" or "wherein the code once obtained unlocks the electronic circuitry or the information stored therein". Therefore, the preceding limitations are not given benefit of the, 11/9/2001, filing date.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "electronic circuitry carried on or in the substrate comprising information stored therein" as well as "the code once obtained unlocks the electronic circuitry or the information

stored therein” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 79, 88, 98, 101, 102, and 104 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a

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previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

- Considering **Claims 79, 88, 98, and 102** contain the limitation of the “substrate comprises multiple components”. A substrate is defined as the material on which a plastic card is printed and therefore by the limitations of the corresponding independent claims, claims 73, 77, 86, 94, 101, and 104, every substrate claimed contains multiple components. Accordingly, the claims are presented in improper dependent form.
- Considering **Claims 101 and 104** contain every limitation of **Claim 86**. “Once recognized unlocks”, once obtained...unlocks”, and “once obtained, allows access” all encompass the same scope. Accordingly, the claims are presented in improper dependent form.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. **Claims 73-77, 79, 81-84, 86, 88, 90-93, 95, 98, 100-102 and 104** are rejected under 35 U.S.C. 102(b) as being anticipated by **Valerij (US 5,790,662)**, herein after "Valerij".

3. Considering **Claims 73, 77, 86, 94, 101, and 104**, Valerij discloses an identification document (column 1- lines 18-20) comprising: a substrate (Fig. 1- item 1); a first graphic carried on or in the substrate (column 1- lines 18-20, it is inherent that a driver's license would include a first graphic), the first graphic representing a photographic image or artwork (column 1- lines 18-20); and electronic circuitry carried on or in the substrate (Fig. 1- item 2, column 2- lines 5-6), wherein the electronic circuitry comprises information stored therein (column 2- lines 10-14), the first graphic comprising steganographically encoding including a plural-bit first message that is machine-readable from optical scan data corresponding to at least a portion of said first graphic (column 7- lines 64-67, column 8- lines 1-12), wherein the first message comprises at least a code (Fig. 1- item 4 and item 5, column 4- lines 57-59, column 5- lines 6-17) and wherein the code once obtained unlocks the electronic circuitry or the information stored therein (column 5- lines 37-51 and 66-67, column 6- lines 1-11 and 26-29).

4. Considering **Claims 74, 83, and 92**, Valerij discloses the substrate comprises multiple layers (column 2- lines 1-2, column 3- lines 1-4).

5. Considering **Claims 75, 82, and 91**, Valerij discloses the identification document comprises at least one of a driver's license, passport, and photo-identification card (column 1- lines 18-24).
6. Considering **Claims 76, 84, and 93**, Valerij discloses the information carried on or in the substrate is utilized as at least one of an encryption key or a decryption key (column 5- lines 66-67, column 6- lines 1-11 and 26-29).
7. Considering **Claims 79, 88, 98, and 102**, Valerij discloses the substrate comprises multiple components (column 2- lines 5-17, Fig. 1).
8. Considering **Claim 81, 90 and 100**, Valerij discloses the machine-readable symbols are steganographically encoded in the photographic-representation of the authorized user (column 7- lines 64-67, column 8- lines 1-12).
9. Considering **Claim 95**, Valerij discloses at least a portion of the information - once processed - is for cooperation with the electronic circuitry or the data stored therein (column 5- lines 37-51 and 66-67, column 6- lines 1-11 and 26-29).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 78, 80, 87, 89, 97, 99, and 103** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij**.

3. Considering **Claims 78, 80, 87, 89, 97, 99, and 103**, Valerij does not explicitly disclose the identification document comprises a passport. Valerij does suggest that the data carrier is suitable for electronic identity media such as driving licenses, health insurance certificates..." (column 1- lines 18-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the data carrier as taught by Valerij in order to provide a data carrier and an associated write/read device with improved security against forgery, imitation or fraudulent use of the data carrier (Valerij- column 1- lines 40-44)

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4. **Claims 85** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij** in view of **Wang (US 5,337,361)**, hereafter "Wang".

5. Considering **Claim 85**, Valerij does not explicitly disclose the symbols represent human readable information. Valerij does suggest that the symbols represent data indicative of an expiration date for the data carrier, which would be human-readable information (column 5- lines 14-15).

Wang discloses the symbols represent human readable information (column 9- lines 28-37, Fig. 7)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Valerij by the symbols representing human readable information as taught by Wang in order to detect counterfeiting. For example, for those records which use photographs for identification, the information on the record could include further identifying information about the owner of the record, such as eye color, hair color, height, weight, etc. Then, if a new photograph were inserted over the appropriate photograph, the information would not match the new photograph and the counterfeiting would be detected (Wang- column 1- lines 48-57).

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6. **Claim 96** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij** in view of **Kristol et al. (US 5,799,092)**, herein after "Kristol."

7. Considering **Claim 96**, Wang does not explicitly disclose at least a portion of the information is to be processed to yield a hash, the hash being for cooperation with the electronic circuitry or the data stored therein.

Kristol discloses at least a portion of the information is to be processed to yield a hash, the hash being for cooperation with the electronic circuitry or the data stored therein (column 4- lines 57-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Valerij using the hash function in cooperation with the data stored in the electronic circuitry as taught by Kristol for the benefit of encoding the image signature (Kristol- abstract, lines 10-12) using a well-known hash function (Kristol- column 4- lines 60-61).

8. **Claim 105** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij** in view of **Leighton (US 5,664,018)**, herein after "Leighton."

9. Considering **Claim 105**, Valerij does not explicitly disclose the information is carried on or in the substrate with digital watermarking.

Leighton discloses the information is carried on or in the substrate with digital watermarking (column 4, lines 38-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Valerij using digital watermarking as taught by Leighton for the benefit of protecting the image and preventing unlawful copying of digitized media (Leighton- col. 1, lines 5-7, col. 3, lines 6-8).

10. **Claim 106** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Valerij** in view of **Behram et al. (US 5,499,293)**, herein after "Behram."

11. Considering **Claim 106**, Valerij does not explicitly disclose the information is obtained from the optical scan data through optical character recognition.

Behram does disclose the information is obtained from the optical scan data through optical character recognition (col. 8- lines 38-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Valerij by obtaining information through optical character recognition as taught by Behram for the

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benefit of using an inexpensive "ink on paper" approach to create the cards
(Behram- column 8- lines 38-42).

Response to Arguments

1. Applicant's arguments with respect to **Claims 73-106** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 5,384,846 – Controlled production of a secure ID card.
- US 4,837,422 – Multi-User card system.
- US 5,379,344 – Smart card validation device.
- US 6,268,058 – Security card with a thin glass layer.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal D. Moran whose telephone number is 571-270-1255. The examiner can normally be reached on M-F: 7:30-5:00.

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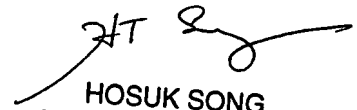
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randal D. Moran

RDM

5/11/07


HOSUK SONG
PRIMARY EXAMINER